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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,582	09/14/2000	Judith E. Schwabe	SUN-P4182	9182

7590 04/29/2004
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EXAMINER

DAS, CHAMELI

ART UNIT	PAPER NUMBER
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2122

DATE MAILED: 04/29/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/661,582

Applicant(s)

SCHWABE, JUDITH E.

Examiner

C.DAS

Art Unit

2122

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Priority Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-87 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-87 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10-11</u> | 6) <input type="checkbox"/> Other: _____ |

1. This action is in response to the applicant's amendment and response to the office action, filed on 12/9/03.
2. In view of applicant's argument, the statutory type (35 U.S.C 101) double patenting rejections of claims 1, 23, 45, 54, 63, 73, 82 and 85 made in the earlier office action is hereby withdrawn.
3. Claims 1-87 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-77 of U.S. Patent Application No. 09/661,581.

Specification

4. The abstract of the disclosure is objected to because the abstract contains more than 150 words in length. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

5. Claims 84 and 87 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 84 and 87 contain the trademark/trade name "Java Card". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used

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properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark to trade name. In the present case, the trademark/trade name is used to identify/describe a virtual machine and, accordingly, the identification/description is indefinite.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-87 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-77 of U.S. Patent Application No. 09/661,581.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variation of each other.

Claim R jections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 23 45, 54, 63, 73, 82-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan et al, US 6,005,942 and further in view of Cline et al, US 5,313,616.

For claim 1, (Chan, Fig 3A, col 4 lines 59-67, col 7 lines 22-25, co 10 lines 27-30, col 19 lines 25-30, col 18 lines 30-40, col 3 lines 30-40, col 16 lines 7-15). Chan does not specifically disclose the binary compatibility. However, Cline discloses the binary compatibility as claimed (Cline, column 4, lines 34-53). The modification would be obvious because one of the ordinary skill in the art would be motivated to ensure that their application program will run on any vendor's certified compatible computer system.

For claim 23, (post-issuance installer (col 4 lines 55-62), untrusted (col 21 lines 50-60, col 24 lines 54-60). For the rest of the limitations see the rejection of claim 1 above.

Claim 45 is the program storage device claim corresponding to the method claim 1 and is rejected under the same reason set forth in connection of the rejection of claim 1 above.

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Claim 54 is the program storage device claim corresponding to the method claim 23 and is rejected under the same reason set forth in connection of the rejection of claim 23 above.

Claim 63 is the system claim corresponding to the method claim 1 and is rejected under the same reason set forth in connection of the rejection of claim 1 above.

Claim 73 is the system claim corresponding to the method claim 23 and is rejected under the same reason set forth in connection of the rejection of claim 23 above.

As per claim 82, (Chan, Fig 3A, col 4 lines 59-67, col 7 lines 22-25, co 10 lines 27-30, col 19 lines 25-30, col 18 lines 30-40, col 3 lines 30-40, col 16 lines 7-15, col 11 lines 1-5, col 8 lines 30-35, col 7 lines 21-30, col 7 lines 41-45, col 15 lines 36-45, col 8 lines 30-40). For binary compatibility, see the rejection of claim 1 above.

As per claim 83, (Chan, abstract).

As per claim 84, (Chan, col 8 lines 30-40).

As per claim 85, (Chan, col 4 lines 55-62, col 21 lines 50-60, col 24 lines 54-60).

For the rest of the limitations see the rejection of claim 1 above.

As per claim 86, (Chan, Abstract).

As per claim 87, (Chan, column 4, lines 50-51).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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TITLE: System for automatically generating tests to ensure binary compatibility between software components produced by a source-to-source computer language translator, US 6425118 B1

TITLE: Software verification apparatus, US 5022028 A

TITLE: Host system elements for an international cryptography framework, US 6178504

TITLE: Streaming media search and continuous playback system of media resources located by multiple network addresses, US 6389467 B1

TITLE: Method and apparatus for verifying a software configuration of a distributed system, US 6360334 B1

TITLE: Method for providing remote software technical support, US 6205579 B1

TITLE: Automatic software downloading from a computer network, US 6347398 B1

TITLE: System, method, and computer program product for uninstalling computer software, US 6668289 B2

TITLE: Method and apparatus for creating and deploying smaller Microsoft Windows applications for automatic configuration of a computing device, US 6405309 B1

TITLE: Computer manufacturing system architecture with enhanced software distribution functions, US 6202070 B1

TITLE: Apparatus and method for error free loading of a programmable non-volatile memory over a datalink, US 5925140 A.

TITLE: System and method for computer based testing, US 5565316 A.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chameli Das whose telephone number is 703-305-1339.

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The examiner can normally be reached on Monday-Friday from 7:00 A.M. to 4:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Tuan Dam can be reached at 703-305-4552. The fax number for this group are:

(703) 746-7239 (official fax), (703) 746-7240 (non-official/draft), (703) 746-7238 (after final).

An inquiry of general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is 703-305-9600.

Chameli C. Das
CHAMELI C. DAS
PRIMARY EXAMINER

4/27/09